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NEW YORK, NY 10017

EXAMINER
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ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statements
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_
- ☐ Notice of Informal Patent Application, PTO-152

Office Action Summary

Art Unit 1771

1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the recent claim amendments, multiple problems, informalities and the like still remain and need to be corrected. Some, but not all of the referred to informalities are as follows. In claim 1, the phrase "sheet strip" is redundant, and, in a similar vein, so is the phrase "extensive stretching pulling". In claim 1 the phrase "the direction of the bond plane" lacks antecedent basis, and in the last line of the claim the word "it" is unclear as to just what is being referred to. Claim 2 appears to be a de facto duplicate of claim 1 and although perhaps not a 35 U.S.C. § 112, second paragraph rejection it appears desirable ~~that~~ to incorporate claim 4 into claim 1 so as to indicate just what frictional force is being referred to. In claim 6, line 2, the word "compositions" in two places is vague, indefinite and out and claim 7 further should utilize proper Markush language,

Art Unit 1771

as should claim 8. In claim 10, several of the informalities which occur in claim 1 are also set forth and should be corrected.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, the Examiner finds the Examples section set forth on pages 7 and 8 of the specification as simply not understood in its present form, particularly the Table set forth on claim 8. That is, it is unclear just what embodiments are being tested and although there is a vague reference to Test Technique DIN 53375, which is briefly discussed elsewhere in the specification the testing techniques themselves are not clearly set forth, in the paragraph as being based upon a non-enabling disclosure.

Art Unit 1771

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

7. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al. -012. (DE 4222849 is cumulative). The reference discloses (note particularly the Abstract, column 1 line 65 - column 2 line 24, column 2 line 51 - column 3 line 4, column 5 lines 49-53, claim 1) what appears to be a substantially

sensitive adhesive) made from the same ingredients that

Art Unit 1771

applicants particularly prefer, that is polystyrene based polyvinyl aromatic block copolymers (column 2 lines 59-63). As regards the grip tab, note that applicants admit in their specification at page 6, line 2 that the corresponding DE -849 possesses "particularly suitable grip tab regions" to those of the invention. As such, the static frictional force possessed by the claimed invention would clearly be inherent, since it is made from essentially the same elements as applicants most preferably employ, or be at most an obvious modification to one of ordinary skill. As to method claim 10, note, e.g. claim 1, for a clear teaching of the nominal method steps using the article taught by the reference.

10. Claims 6-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lühmann et al. -912 taken either individually or in view of Lühmann et al. -932. (DE 4431914 is cumulative). The primary reference is again relied upon substantially as set forth above, with the limitations that the grip tab is coated with either "deformable" or low tack "compositions" such as silicones, EVA compounds or PU compounds are believed to be well known to one of ordinary skill in the art. Alternatively, note Lühmann et al. -932 at column 2 line 66

2, note again the admission at page 6, line 2 of the

Art Unit 1771

specification where both of these references are taught as having "particularly suitable grip tab regions" as well as the Examiner's contention that such techniques and the utilization of EVA or PU "sheet" (claim 9) are both believed to be well within the ordinary skill of the art. Other parameters that are not either expressly or inherently disclosed are each also believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Wollner.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Serial No. 10/014,709

-7-

Art Unit 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

May 7, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zirker*